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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,030	03/26/2001	Yuji Iguchi	010148	3374

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
1774	6

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/806,030

Applicant(s)

IGUCHI ET AL.

Examiner

Betelhem - Shewareged

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6 and 9 is/are rejected.
- 7) ☒ Claim(s) 2,4,5,7,8,10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's response filed on the 09/20/2002 has been fully considered. All rejections have been withdrawn in view of Applicant's comments and submission of English translation of the requested foreign test standard. Claims 1-12 are pending.

NOTE: non-elected claim 12 is still withdrawn from consideration.

### ***Election/Restrictions***

2. Applicant's election without traverse of Group I claims 1-11 in Paper No. 5 is acknowledged. The election/restriction requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Arai et al. (US 6,326,055).

Arai discloses an image receiving sheet comprising a base and a receiving layer (col. 7, line 2). The receiving layer is made of a coating composition containing a resin such as polyurethane, polyvinyl alcohol or polyvinyl acetate (col. 7, line 21), a filler or colorant such as zinc sulfide, silica, talc or alumina (col. 8, line 22). The receiving layer is equivalent to the claimed ink receiving layer. Arai receiving layer has an arithmetic mean surface roughness value of 0.1-4.0 measured in accordance with JIS B 0601 (col. 11, lines 1-5). The above roughness value is within the claimed range. The base may be a paper made of cellulose fiber (col. 11, line 25). In view of the specification of the current application, the claimed fabric support may be made of natural fibers. Cellulose fiber is a natural fiber, therefore, the claimed fabric support reads on the base paper made of cellulose fiber of Aria. With respect to surface glossiness value of the ink receiving layer, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Arai reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article functions in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nitta (US 6,028,028) in view of DeMatte et al. (US 5,985,424) and Aerosil/Degussa Website.

Arai discloses an image receiving sheet comprising a base and a receiving layer (col. 7, line 2). The receiving layer is made of a coating composition containing a resin such as polyurethane, polyvinyl alcohol or polyvinyl acetate (col. 7, line 21), a filler or colorant such as zinc sulfide, silica, talc or alumina (col. 8, line 22). The receiving layer is equivalent to the claimed ink receiving layer. Arai receiving layer has an arithmetic mean surface roughness value of 0.1-4.0 measured in accordance with JIS B 0601 (col. 11, lines 1-5). The above roughness value is within the claimed range. The base may be a paper made of cellulose fiber (col. 11, line 25). In view of the specification of the current application, the claimed fabric support may be made of natural fibers. Cellulose fiber is a natural fiber, therefore, the claimed fabric support reads on the base paper made of cellulose fiber of Arai. With respect to surface glossiness value of the ink receiving layer, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Arai reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article functions in the same

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manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on

Arai does not disclose a gas phase method or fumed silica having the claimed particle size and BET surface area.

DeMatte teaches an ink jet recording layer comprising a basestock, a base coat having pigments (col. 3, line 15), and an ink receiving layer in the order thereof (col. 2, line 54). The claimed pigment layer is equivalent to the base coat layer. The ink receiving layer contains a binder and a fumed silica having a BET surface area of 140-200 m<sup>2</sup>/g and a particle size of 15 nm (see AEROSIL datasheet).

Arai and DeMatte are analogous arts because they are from the same field of endeavor that is the ink jet recording medium art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the fumed silica of DeMatte with the ink jet recording sheet of Arai so as to control the ink absorption of the receiving layer.

### ***Allowable Subject Matter***

7. Claims 2, 4, 5, 7, 8, 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

BS/BS  
December 2, 2002.

SEARCHED  
SERIALIZED  
INDEXED  
FILED

Cynthia H Kelly